



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,525	09/29/2000	Ronald W. Barrett	019282-000210US	1576

7590 06/03/2003

TOWNSEND and TOWNSEND and CREW LLP
8th Floor
Two Embarcadero Center
San Francisco, CA 94111-3834

EXAMINER

LEFFERS JR, GERALD G

ART UNIT	PAPER NUMBER
1636	18

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/675,525	BARRETT ET AL.
	Examiner	Art Unit
	Gerald G Leffers Jr.	1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 17 March 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-126 is/are pending in the application.

4a) Of the above claim(s) 4,10,13-21,43,51-53 and 55-126 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3,5-9,11,12,22-42,44-50 and 54 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7 and 14</u> .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I (claims 1-44) in Paper No. 17 (filed 3/17/03) is acknowledged. The following species were elected without traverse: Linker/binding pair= aldehyde/hydrazid linker and biotin/streptavidin; displayed compound= the dye Dansyl-X, succinimidyl ester; species of nucleic acid tag= AGGGAAGAAGAGAAAGAAGGG; replicable genetic package= bacteriophage T7.

Upon further consideration of the claims, claims 45-54 have been rejoined with Group I since some of the elected claims recite the limitation that the displayed compound is joined to the phage via a linker. Thus claims 1-54 have been elected, with claims 1-3, 5-9, 11-12, 22-42, 44-50 and 54 read on all of the elected species. Claims 4, 10, 13-21, 43, 51-53 and 55-126 have been withdrawn from consideration as being directed to non-elected species or non-elected inventions.

Sequence Compliance

Receipt is acknowledged of a paper copy of the sequence listing, corresponding computer readable form and attorney's statement concerning the content of the sequence listings, filed as Paper No. 12 on 4/11/03. The sequence listings have been entered into the file. The application is now in sequence compliance.

Information Disclosure Statement

Receipt is acknowledged of a pair of information disclosure statements, filed 1/25/01 and 7/11/02 as Papers No. 7 & 14, respectively. The signed and initialed PTO Form 1449's have been mailed along with this action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5-9, 11-12, 22-42, 44-50 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite in that the metes and bounds of the phrase "...displaying a compound other than an expressed polypeptide..." are unclear. Does the phrase mean that a compound polypeptide must be made synthetically (i.e. not expressed by any cell) or simply that it is not expressed by the replicable package? Upon reading the specification it appears that the latter interpretation is correct. It would be remedial to amend the claim language to explicitly state that the compound is other than a polypeptide expressed by the replicable genetic package.

Claim 1 is also vague and indefinite in that the metes and bounds of the phrase "...wherein the replicable genetic package comprises a nucleic acid tag encoding a characteristic of the compound..." are unclear. The use of the word "encoding" in reference to a nucleic acid is normally interpreted to mean that nucleic acid is encoding a particular RNA or polypeptide. In the instant case, however, it appears upon reading the specification that applicants intend the

Art Unit: 1636

nucleic acid to correlate to a particular compound as a means of identification of the particular compound displayed by a particular replicable package. The degree of correlation is also not clear. The specification appears to indicate that the specific sequence of the nucleic acid tag somehow "codes" for particular synthesis steps in the construction of the compound. It is not clear how this alternative type of coding functions or whether this type of "coding" is necessarily specified in the claim. It would be remedial to amend the claim language to clarify the role the nucleic acid tag is to play in display/identification of a particular replicable package.

Claim 39 is vague and indefinite in that it appears to specify that a single replicable genetic package comprises a collection of replicable packages. It is not clear how this is meant. If applicants mean that they are claiming a collection of replicable packages, then claim 39 should be rewritten as an independent claim.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald G Leffers Jr. whose telephone number is (703) 308-6232. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7939 for regular communications and (703) 305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Gerald G Leffers Jr.
Examiner
Art Unit 1636

Ggl
June 2, 2003